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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,699	11/24/1999	KATSUNORI TSUTSUMI	990723/LH	6591
1933	7590	01/14/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023			BASHORE, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/449,699		TSUTSUMI ET AL.	
	Examiner		Art Unit	
	William L. Bashore		2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,13,17-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,13,17-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received. (See Action)
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to the following communication: amendment filed November 15, 2004, to the original application filed November 24, 1999. Application claims benefit of priority filing dates: 12/24/1998, and 12/22/1998. IDS filed 11/15/2004.
2. Claims 12, 17, 19, 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus and Mastie.
3. Claim 13 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus, Mastie and Aoyagi.
4. Claim 18 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus, Mastie and Kanerva.
5. Claims 12-13, 17-19, 21 pending. Claims 14-16, 20 have been canceled. Claims 12, 17, 19, 21 are independent claims.

Priority

6. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in December 22, 1998 and December 24, 1998. It is noted, however, that applicant has not filed a certified copy of the applications (JAPAN 365309/1998 and JAPAN 367795/1998 as required by 35 U.S.C. 119(b).

It is respectfully noted that in the Office action mailed May 22, 2003, the previous examiner of record indicated receipt of priority documents, said documents placed in the record accordingly. The present examiner of record confirmed this in all subsequent actions (up to Office action mailed August 11, 2004), however, said documents are absent from the recently scanned IFW (Image File Wrapper) record. Applicant is respectfully requested to resubmit the above priority documents so that the scanned record can be updated accordingly.

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Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **The claimed invention (as claimed in claims 19, 21) is directed to non-statutory subject matter.**

In regard to independent claims 19, 21, each said claim is claiming "*A storage means for storing a computer readable program code, said program code comprising...*". Regarding both claims, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. The examiner's suggestion of amending each said claim to recite "*A computer readable program code embodied on a computer readable medium, the execution of said code by a computer causing said computer to perform the following instructions comprising...*", will overcome this rejection.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 12, 17, 19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al, U.S. Patent No. 6,327,599 B1 issued 12/4/2001, in view of Mastie (hereinafter Mastie), U.S. Patent No. 6,480,866 issued 11/12/2001.

In regard to independent claim 12, Warmus et al. teach converting means for converting a plurality of documents formed by application programs into page document data to be outputted every page and storage means for SPOOL-storing each of the page document data converted by the converting means. (Warmus et al., col. 5, lines 41-48: "The master and variable page files and the press command file are converted by a collator and raster image processor (RIP) into bitmaps which may be stored in a memory. The stored bitmaps are used to control one or more demand printers and/or any other type of display device, such as a laser printer, a CRT, an LCD display or the like so that the device displays pages having fixed and variable information thereon.")

Further, Warmus et al. teach output-subject setting means for designating desirable page document data as output-subject document data SPOOL-stored in said storage means (Warmus et al., col. 8, lines 9-12: "A database 108 is also developed by the publisher using the personal computer 54 specifying the content of variable information to be placed in variable information areas, for example, the areas 110, 112 on the pages P1, P4, respectively, of FIGS. 6a and 6b."), and for setting an output condition when each of said designated output-subject document data is outputted. (Warmus et al., col. 9, lines 57-59: "Following the block 158, a block 160 prompts the user to enter an indication of whether the image object is to be displayed in one of two display formats.").

Further, Warmus et al. teach output control means for outputting page document data designated from the respective page document data SPOOL-stored in the storage means based on the contents designated/set by the output-subject setting means in accordance with said output condition. (Warmus et al., col. 8, line 57 – col. 9, line3: "The files 130, 132 are then converted into variable page files 134, 136. The files 134, 136 are identical to the files 130, 132, respectively, except that the data in each file identifying entries in the database are replaced by the actual data stored at such entries. . . . The print system 79 operates in response to the press commands in

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a press command file 140 and merges the page files 122, 137 and 138 (if no imposition is to be effected) or merges the page files 124 and 139 (if the pages are imposed) to create the finished books or book versions.”).

Warmus et al. teach output-subject setting means forming a virtual document file and setting both designation information and an output condition inasmuch as Warmus et al. teach a bitmap equivalent to a virtual document file (Warmus et al., col. 5, lines 41-43) that would have inherently included designation information (*i.e.*, what was included in the file) and an output condition (*i.e.*, the format and order in which content was outputted).

Further, Warmus et al. teach outputting page document data in accordance with the output condition, and the outputted page document data is designated from the respective page document data SPOOL stored in the storage means based upon the content which is set by the output-subject setting means as the storage information in the virtual document file. (Warmus et al., col. 5, lines 43-47: “The stored bitmaps are used to control one or more demand printers and/or any other type of display device, such as a laser printer, a CRT, an LCD display or the like so that the device displays pages having fixed and variable information thereon.”)

Warmus et al. does not teach arbitrarily setting a desirable portion as a sequential number information adding area as an output condition when the designated data is outputted and adding (amending) a sequential number to every page to the area set as the sequential number information adding area. However, inasmuch as Warmus et al. teaches formatting a book (Warmus et al., col. 5, lines 18-20), and it was well known in the art that book pages advantageously contain page numbers, the recited claim limitations would have been obvious to one of ordinary skill in the art at the time of the invention, providing a user of Warmus the benefit of sequential page numbering to aid in finding pages.

Warmus et al. does not specifically teach “individual” pages. However, Mastie teaches creation of a single output file from a plurality of inputted page files, each file can represent an individual page, and said files can be written in PDL. The correct sequence of pages is determined (*i.e.* page sequence for numbering), than a framework is created, and pages are modified accordingly to fit said framework (Mastie column 3 lines 38-50, Figure 5, column 7 lines 14-18, 24-32; compare with claim 12 “*individual pages*”). It would have been obvious

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to one of ordinary skill in the art at the time of the invention to apply Mastie to Warmus, providing Warmus the benefit of transforming separate pages into a single file to eliminate manual collating of pages (Mastie column 7 lines 16-19).

In regard to independent claim 17, claim 17 incorporates substantially similar subject matter as claimed in claim 12, and is rejected along the same rationale.

In regard to independent claim 19, claim 19 reflects the computer program product comprising computer executable instructions used for implementing the apparatus as claimed in claim 12, and is rejected along the same rationale.

In regard to independent claim 21, claim 21 reflects the computer program product comprising computer executable instructions used for implementing the apparatus as claimed in claim 17, and is rejected along the same rationale.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al. and Mastie as presented in claim 12 above, and further in view of Aoyagi, U.S. Patent Number 5,88,103 issued 12/24/1996.

In regard to dependent claim 13, Warmus et al. do not specifically teach masking an area for a page number and adding another page number based upon a virtual document. However, Aoyagi suggests such a limitation by pointing out the benefits of suppressing unnecessary details. (Aoyagi, col. 1, lines 15-23.) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have

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output-subject setting means arbitrarily setting a desirable portion contained in Warmus's page document data (i.e. page numbering) as an output-suppressing area.

Further, given the benefits of using a mask taught by Aoyagi, noted above, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the output control means outputting as a mask such data corresponding to the area set as the output-suppressing area by the output-subject setting means.

12. **Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al. and Mastie as presented in claim 17 above, and further in view of Kanerva et al., U.S. Patent No. 6,470,363 issued October 22, 2002 (previously cited reference).**

In regard to dependent claim 18, Warmus does not specifically teach icons. However, Kanerva teaches Microsoft Office Binder, which utilizes icons reflecting various sections of a document (Kanerva et al. Figure 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Kanerva to Warmus, providing a user of Warmus the benefit of icons for easy manipulation of document sections.

Response to Arguments

13. Applicant's arguments filed 11/15/2004 have been fully and carefully considered but they are not persuasive.

It is respectfully noted that Applicant's amendment to the instant claims significantly changes the scope of the claimed invention when interpreted as a whole.

Applicant stresses on page 14 (bottom) to page 15 (at top) that the claimed invention can process virtual document data formed using different application programs. Applicant also argues on pages 15-16 that Warmus and Mastie do not teach that the bitmaps formed by various respective application programs are all converted

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into “virtual document data”. It is respectfully noted that spooling data for printing is associated with designation of a printer. In addition, the instant claims do not preclude the examiner from applying the broadest reasonable interpretation to “virtual document data” within the scope of the relevant art. The examiner has included a reference (cited but not used in the instant rejection) defining a document as (in addition to word processed material) a collection of characters (from the point of view of a computer), therefore a spreadsheet or a graphic (i.e. a pdf file) is as much a document as a letter or a report (Microsoft Press Computer Dictionary, 1997, page 156).

It is respectfully noted that, in addition to the instant rejections, although Applicant claims “respective different kinds of application programs” the instant claims do not preclude the interpretation of two different programs which can convert documents accordingly. A wpd document can be created on WordPerfect. Microsoft Word (a different application) can convert the WordPerfect document (including its page numbers) into a doc file (a different type of document) and combine it with an existing doc file (using import, merge, copy/paste, etc.). Word also renumbers pages automatically (when pages are added, deleted, etc.).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

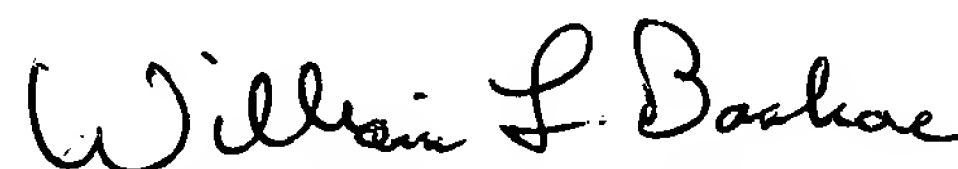
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WILLIAM L. BASHORE
PATENT EXAMINER
TECH CENTER 2100

January 8, 2005